

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:	)	
	)	
Winslade, <i>et al.</i>	)	
	)	
Serial No. 09/687,499	)	<b>Electronically Filed on</b>
	)	
Filed: October 13, 2000	)	<b>December 30, 2011</b>
	)	
For: System for Online Sales with	)	
Automatic Rebate and Coupon	)	
Redemption	)	
	)	
Examiner: Retta, Yehdega	)	
	)	
Group Art Unit: 3622	)	
	)	
Confirmation No. 1146	)	
	)	

REPLY BRIEF

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is filed in response to the Examiner's Answer mailed November 03, 2011. For the reasons discussed in previous submissions as well as below, the Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 34-39 of the present application. This Reply Brief is timely because it is being filed within two months of the November 03, 2011 mailing date of the Examiner's Answer.

## REMARKS

### I. Claims 34 and 35 Are Not Unpatentable

The Examiner's Answer maintains the rejections of all pending claims. Appellants begin by addressing claims 34 and 35, which stand rejected as purportedly anticipated by Meyer (U.S. Patent No. 6,915,271). Appellants again note that to anticipate, a single prior art reference must disclose each and every element **as set forth** in the claim, either expressly or inherently described, and that the elements of the claim **must be arranged as required** by the claim. (See MPEP § 2131.) Instead of making such a showing, the Answer merely provides a hodgepodge variety of purported systems or parties of Meyer that are not arranged as in the claims and do not teach all of the limitations of the claims. Further, the Answer ignores express claim language in asserting that Meyer anticipates. Because, as discussed below and in previous submissions, Meyer does not disclose each and every element of the presently claimed subject matter in the required detail or arranged as required, Meyer does not anticipate the presently claimed subject matter.

Starting with claim 34, Appellants note that claim 34 recites, *inter alia*, "offering, by a second system of a second party, an item for sale online at a sales price amount, wherein the item for sale can be identified on the second system by a customer using the second system" and "providing, by the second system, a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party

associated with the item for sale, wherein the customer can search for the promotion after the customer has identified the item for sale on the second system, the promotion having a promotion amount.” In the Appeal Brief, Appellants discussed how the claim requires that it is the second system that offers the item for sale and provides a portal wherein the customer can search for a promotion from the first party, **after** the customer has identified the item for sale on the second system. In other words, a promotion is offered by a first party having a first system, the second system offers an item for sale online that can be identified on the second system by a customer, and the second system provides a portal containing a plurality of promotions wherein the customer can search for the promotion after the customer has identified the item for sale on the second system. The Examiner’s Answer, however, continues to rely upon different, distinct systems as teaching the various aspects of the second system (which is arranged as a single system by claim 34), and also continues to rely upon the Buy Now feature of Meyer, where any purported promotion is known before an item for sale is identified. (See Appeal Brief at p. 9-14; Examiner’s Answer at p. 4-5.)

In responding to Appellants’ discussion in the Appeal Brief, the Examiner’s Answer begins by asserting that

...Meyers teaches an incentive issuer as a merchant or manufacturer of goods or services...that desires to promote its products or services by offering incentive...(col. 116, lines 1-5)...a promotion agency would select service provider to use for the promotional campaign...an incentive issuer may run a promotion without using a third party...for example, a merchant such as CIRCUIT CITY may issue a

set of promotions related to goods sold at its store, and act as the sponsor of the promotion...(see col. 16 lines 48-67). Meyers teaches displaying a portal including a plurality of promotions (incentive) wherein a customer can search for incentives associated with items for sale. Meyers teaches items for sale (see fig. 19 and 20), for example, the Sony Camcorder is an item for sale offered by the second system. The portal also includes promotion provided by a first party (merchant or manufacture). The customer is aware of the items for sale at the second system before searching for the promotions.”

(Answer at p. 8.) As an initial matter, even assuming *arguendo* that Meyer teaches what the Answer asserts it as teaching, such teachings of miscellaneous merchants, manufacturers, promotion agencies, incentive issuers, sponsors of promotions, and/or a “portal including a plurality of promotions” does not teach the method as specifically set forth by claim 34, which expressly assigns specific aspects to a first party having a first system and a second party having a second system. Because Meyer does not teach each and every limitation, let alone each and every limitation arranged as required by the claim (e.g. associated with the claimed party and/or system as described by the claim), Meyer cannot anticipate. Further still, whether or not the “customer is aware of the items for sale at the second system before searching for the promotions” does not teach the claimed subject matter. For example, claim 34 recites “offering, by a second system of a second party, an item for sale online at a sales price amount, wherein the item for sale can be identified on the second system by a customer using the second system.” Whether or not a customer is “aware” of an item for sale teaches nothing with respect to offering an item **for sale** at a sales price **by the**

**second system** as fully set forth by claim 34.

In response to Appellants' previous demonstration of the inadequacies of Meyer's teaching, including the "Buy Now" feature, the Answer first asserts that claim 34 "merely recites offering items for sale online and providing portal [sic] containing a plurality of promotions." (Answer at p. 9; see also *id.* at p. 11.) Such an assertion is obviously incorrect. The claim does not "merely" recite offering items for sale online, but instead recites, *inter alia*, "offering, by a second system of a second party, an item for sale online at a sales price amount, wherein the item for sale can be identified on the second system by a customer using the second system" – this is far more detailed than just offering something online, as it includes specific descriptions of the offering including recitations that the offering is by a second system of a second party, that the item is offered for sale at a sales price, and wherein the item for sale can be identified on the second system by a customer using the second system.

Nor does the claim "merely" recite providing a portal containing a plurality of promotions. Instead, the claim recites "providing, by the second system, a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion after the customer has identified the item for sale on the second system, the promotion having a promotion amount" – thereby reciting that the portal is provided wherein the customer can search for a promotion from the first party after the customer has identified the item for sale on the second system. The portal therefore

must be provided after the customer has identified the item for sale on the second system, or it could not be searched after the customer has identified the item for sale on the second system.

The Answer improperly ignores entire lines of claim language in asserting that the claim merely recites, *inter alia*, “offering items for sale online and providing portal [sic] containing a plurality of promotions.” Only by ignoring these expressly recited claim limitations can the Answer attempt to support an anticipation rejection based on Meyer.

The Answer goes on to assert that “the claim does not recite that the customer first selects the item for purchase at the second system and after the customer selected the item for purchase then searches for a promotion from the first party.” (Answer at p. 9.) However, the claim expressly states “providing, by the second system, a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion after the customer has identified the item for sale on the second system.” Again, for the customer to search the portal (provided by the second system) after identifying the item for sale on the second system, the portal must be provided after such an identification on the second system. Whether or not the claim includes a separate step of “searching” or a step of “identifying,” (see Answer at p. 9) the steps of “offering...” and “providing...” include express limitation regarding the identification of items and search for promotions that cannot somehow just be ignored.

The Answer also states, "It has been held that Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation." (Answer at p. 10.) However, the presently at issue language does not merely suggest, or make optional, but requires the steps of offering and providing as fully set forth in detail in the claim. That the portal is described as "wherein the customer can search..." does not make any recited aspect of the providing step optional, but instead provides description of additional limitations on the portal and providing step. The Answer also asserts that claim 34 "does not identify the first party being different from the second party." (See *id.* at p. 9.) However, the claim plainly identifies a first party/system and second party/system, and describes specific aspects of each party/system. The parties are therefore plainly different, and, in any event, mixing and matching parties as the Answer attempts to do cannot teach the method arranged as required by claim 34, and cannot anticipate. (See MPEP § 2131.)

The Answer also attempts to provide an unreasonably broad interpretation of claim language. For example, the Answer states, "Regarding the phrase 'the customer has identified the item' claims are to be given their broadest reasonable interpretation in light of the supporting disclosure." (See Answer at p. 10.) However, the Answer's "interpretation" of "the customer has identified the item" misses the point by not considering the entire phrase, as it parses out key language of the actual phrase used in claim 34: "wherein the customer can search for the promotion **after** the customer

has **identified the item for sale on the second system.**" The Answer ignores that the identification is of an item for sale on the second system. Only by ignoring this language can the Answer later assert, "Examiner points out that the claim does not recite that the item for sale is offered first." (See Answer at p. 11.) That assertion ignores the claim language, which recites that the item is offered for sale (on the second system), and further still recites that the customer can search for the promotion **after** the customer has identified the item **for sale**.

Further, the Answer asserts "the customer can make such an identification of the item for sale by viewing the items displayed by at the incentive provider (which also provide incentive)" and that the "customer searches for the item to purchase by searching the item which also includes the incentive." (See Answer at p. 12.) Again, however, these assertions ignore the claim's recitation that it is the second system that also offers the item for sale. The purported searches relied upon by the Answer are not performed on a portal provided by the same system that offers the items for sale. Whether or not a customer can search for an item does not teach anything with respect to the offering, by the second system, an item for sale as fully set forth by claim 34. Again, for the Buy Now feature of Meyer, any purported promotion is necessarily known before an item for sale is identified (on any system). The Answer, similar to the final Office Action, again fails to provide any explanation for how or why such a feature could teach anything relating to a search for a promotion after identifying an item for sale, as it is the incentive itself in Meyer from which the customer is directed to an item for



purchase.

Appellant respectfully submits that Meyer does not teach at least the steps of “offering, by the second system...” and “providing, by the second system...” as fully set forth by claim 34. For example, Appellants respectfully submit that Meyer does not teach a second system that both offers the item for sale and provides a portal containing a plurality of promotions, let alone providing such a portal wherein a customer may search for promotions after the customer has identified an item for sale on the second system. For at least the above reasons, in addition to those discussed in previous submissions, Appellants respectfully submit that claim 34 is not anticipated by Meyer, and that claim 34 is allowable.

Turning to claim 35, Appellants note that claim 35 recites, *inter alia*, “causing, by the second system, shipment by the second party of the item for sale to the buyer.” In response to Appellants’ demonstration that the purported “second party” of Meyer does not ship, the Answer responded: “Examiner points out that in Meyer’s [sic] the first and second party can be the same (see col. 16, lines 1-67). Appellant’s claim does not recite that the second party is different than the first party.” (Answer at p. 12.)

First, whether or not Meyer’s first and second party can be the same (assuming, *arguendo*, that they can) does not teach first and second parties as fully set forth by claim 35. Second, claim 35 recites first and second parties and systems that have plainly different recited aspects. The two parties/systems are arranged differently from each other by the claim language describing them, and any purported teaching of the

same party as teaching both parties or systems cannot anticipate, as such a teaching would not be arranged as required by the claim. Third, in any event, the claim expressly states "wherein the second system is distinct from the first system and the second party is distinct from the first party." Again, the Answer ignores express claim language in making its assertions. Only by ignoring claim 35's express recitation "wherein the second system is distinct from the first system and the second party is distinct from the first party" can the Answer attempt to assert Meyer as anticipating. (*Compare* Answer at p. 12 "Appellant's claim does not recite that the second party is different than the first party" with claim 35 "...wherein the second system is distinct from the first system and the second party is distinct from the first party...")

For at least the above reasons, in addition to those discussed in previous submissions, Appellants respectfully submit that claim 35 is not anticipated by Meyer, and that claim 35 is allowable.

## **II. The Proposed Combinations Do Not Render Claims 36-39 Unpatentable**

Appellant now turns to the rejection of claims 36-39 as purportedly obvious.

With respect to claim 36, the Answer asserts that a merchant or manufacturer may be an incentive issuer, that an incentive issuer may act as its own promotion agency, and that an incentive issuer may run a promotion without using a third party and that, "[t]herefore, if the sponsor is the merchant, the products or items for sale are acquired from the manufacturers" and "[i]f the sponsor is the third party, the products

are acquired from the merchants since the products are sold at the third party.” (See Answer at p. 12.) However, the Answer provides no explanation for, in its hypothetical “if the sponsor is the merchant,” how the promotion would be from a first party, with the item offered by a second party that has acquired the item from the first party. And, in its hypothetical “if the sponsor is the third party,” the Answer provides no explanation for how the promotion would be from a first party, with the item offered by a second party that has acquired the item from the first party. Nor does the Answer explain how or why Meyer purportedly teaches selling products acquired from merchants “at the third party.”

This is particularly so because the Answer states that Meyer teaches that “the sponsor is the issuer.” (Answer at p. 12.) Thus, in the hypothetical “if the sponsor is the merchant,” the purported second party (that, *inter alia*, offers the item for sale and acquires the item for the first party) is the same as the purported first party (as claim 36 recites “A method of processing a promotion for a first party...the item for sale having associated with it a promotion form the first party...”). However, the first and second parties (and systems) of claim 36 are distinct. And, in the hypothetical “if the sponsor is the third party,” the Answer provides no explanation for how or why a second system would or could acquire an item from such a “third party,” let alone how such a hypothetical could render claim 36 obvious. Nor does the Answer provide any reasoned explanation of how the “Buy Now” feature of Meyer provides any teaching whatsoever with respect to a second party as described by claim 36, for example, acquiring or shipping an item. The Answer merely identifies hypothetical parties without

providing any reasoned, understandable explanation for how or why Meyer, alone or in combination with other art, teaches, suggests, or otherwise render obvious the claimed method of claim 36, including the specific aspects of the distinct parties and systems as fully set forth by claim 36. Such an approach cannot provide a *prima facie* showing of obviousness.

Also with respect to claim 36, Appellants previously demonstrated Murphy's failure to remedy Meyer's acknowledged lack of teaching, suggesting, or rendering obvious "collecting, by the second system, a service fee associated with the online purchase request." The Answer, in response, asserts that "Murphy teaches a web site including a central site incentive program server 22, a manufacture (or other incentive issuers), and retail (or other redemption) facilities (see [0074]...the central server 22 which receives and stores the user incentive information charges the users a fee (see [0090]-[0094].)" However, these cited portions do not teach, for example, collection of a service fee by a second system that also, for example, offered the item for sale online. Such a bare teaching of a service fee or a web site including a central site incentive program server cannot be stretched so far as to teach, suggest, or otherwise render obvious "collecting, by the second system, a service fee associated with the online purchase request," especially in light of claim 36's express recitations describing the second system. Appellants' demonstration of the inadequacies of the cited references is not an improper "attacking references individually." This is even more so in light of the Answer's acknowledgement that Meyer fails to teach this aspect of claim 36. (See

Application Serial No. 09/687,499  
Reply Brief  
December 30, 2011

Answer at p. 7.) The cited references, either alone or in combination, do not teach, suggest, or otherwise render obvious claim 36.

Appellant also notes that the Answer fails to respond in any way to Appellants' discussion of claim 38 in the Appeal Brief. For at least the reasons discussed above and in previous submissions, Appellants respectfully submit that the Office Action does not present a *prima facie* showing of claim 36 or any claim dependent therefrom as obvious in light of Meyer in view of Murphy, and that those claims are allowable.

Similarly, with respect to Appellants' previous demonstration of the inadequacies of Holda-Fleck, the Answer asserts that "Holda-Fleck was relied upon for the teaching of collecting a fee from a first party by a second party not for the teaching of online purchase request." (See Answer at p. 14.) Claim 36 does not merely claim collecting a service fee from one party by another party. Claim 36 recites "collecting, by the second system, a service fee associated with the online purchase request." A bare teaching of collection of any service fee cannot be stretched so far as to render claim 36 obvious. This is even more so in light of the differences in the fees of Holda-Fleck compared with claim 36, as previously noted in the Appeal Brief. (See Appeal Brief at p. 20-21.) Neither Meyer nor Holda-Fleck, either alone or in combination, teaches, suggests, or otherwise renders obvious the collecting of a service fee associated with an online purchase request by a second party as fully described by claim 36.

For at least the reasons discussed above and in previous submissions, Appellants respectfully submit that the Office Action does not present a *prima facie*

Application Serial No. 09/687,499  
Reply Brief  
December 30, 2011

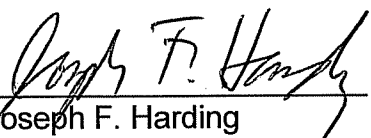
showing of claim 36 or any claim dependent therefrom as obvious in light of Meyer in view of Holda-Fleck, and that those claims are allowable

### III. Conclusion

For at least the reasons discussed above, the Appellants respectfully submit that the pending claims are allowable in all respects. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 34-39. While no fee is believed due with this paper, the Commissioner is hereby authorized to charge any additional fees which may be required or credit any overpayment to Account 13-0017.

Date: December 30, 2011

Respectfully submitted,

  
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